

**Notice of Allowability****Application No.**

09/767,110

**Applicant(s)**

HICKS, SCOTT G.

**Examiner**

J. Bret Dennison

**Art Unit**

2143

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 09/03/2004.
2. ☒ The allowed claim(s) is/are 1-3,5,7-12,14,15,17,19-25 and 27.
3. ☒ The drawings filed on 21 January 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 12/08/2004.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

*Will C. Vaughn, Jr.*  
Primary Examiner  
Art Unit 2143  
William C. Vaughn, Jr.

*JBW*

### **DETAILED ACTION**

This Action is in response to Application Number 09/767,110 received on 03 September 2004..

Claims 1-12, 14-25, and 27 are presented for examination.

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Jennifer Stewart (Registration Number 53639) on 12/08/2004.

Please cancel claims 4, 6, 16, and 18.

Please amend claims 1, 5, 15, 17, and 24 as follows:

1. (Currently Amended) A method of storing an e-mail address within an Abbreviated Dialing Number (ADN) record of a Subscriber Identity Module (SIM) card, the ADN record including a plurality of fields having personal contact information relating to a contact stored in the ADN record, said method comprising the steps of:

allocating a first number of bytes of memory space to a first field in the ADN record;

storing an e-mail address of a contact in the first field in the ADN record;

setting a flag in a second field in the ADN record indicating a presence of an e-mail address in the first field in the ADN record[.]; [and]

allocating a third byte from said first number of bytes in the first field in the ADN record for identifying a length of the e-mail address stored in the first field[.];

wherein the second field in the ADN record comprises a Type of Number/Numbering Plan Identification (TON/NPI) field; and

wherein an NPI portion of the TON/NPI field includes four binary bits, and wherein the step of setting a flag in the second field in the ADN record indicating the presence of an e-mail address in the first field in the ADN record comprises the step of setting the NPI portion of the TON/NPI field equal to binary "1110".

2. (Original) The method of claim 1, wherein the first number of bytes allocated to the first field in the ADN record is equal to or less than 241 bytes.

3. (Original) The method of claim 1, wherein the first field in the ADN record comprises an Alpha Identifier field.

4. (Canceled)

5. (Currently Amended) The method of claim [4] 1, wherein the flag indicating the presence of an e-mail address in the first field in the ADN record is set in an NPI portion of the TON/NPI field.

6. (Canceled)

7. (Original) The method of claim 1, wherein the ADN record includes a third field for storing a dialing number associated with the contact, and wherein the method further comprises the step of coding the third field in the ADN record as unused.

8. (Original) The method of claim 1, wherein the ADN record includes a third field for storing a dialing number associated with the contact, and wherein the method further comprises the step of storing an invalid phone number in the third field in the ADN record.

9. (Previously Amended) The method of claim 1, wherein the method further comprises the step of allocating a first byte in the first field in the ADN record for identifying a second ADN record containing a phone number for the contact.

10. (Previously Amended) The method of claim 9, wherein the second ADN record further includes an alphanumeric tag associated with the contact.

11. (Original) The method of claim 1, wherein the method further comprises the step of allocating a second byte in the first field in the ADN record for identifying an extension record containing a remaining portion of the e-mail address if the first number of bytes

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of memory space allocated to the first field in the ADN record is insufficient to store the e-mail address.

12. (Original) The method of claim 11, wherein the ADN record includes a fourth field for storing an extension record identifier, wherein the extension record identifier in the fourth field and the second byte in the first field each identify the extension record containing the remaining portion of the e-mail address if the first number of bytes of memory space allocated to the first field in the ADN record is insufficient to store the e-mail address.

13. (Canceled)

14. (Previously Amended) The method of claim 1, wherein the method further comprises the step of additionally storing an alphanumeric tag associated with the contact in the first field in the ADN record.

15. (Currently Amended) A method of storing an e-mail address within an Abbreviated Dialing Number (ADN) record of a Subscriber Identity Module (SIM) card, the ADN record storing subscriber-specific contact information relating to subscriber contacts and including a Dialing Number field having a first number of bytes of memory space for typically storing a phone number associated with a subscriber contact and an Alpha Identifier field having a second number of bytes of memory space for typically storing a

subscriber-defined alphanumeric tag associated with the subscriber contact, said method comprising the steps of:

storing an e-mail address in the Alpha Identifier field of the ADN record associated with a particular subscriber contact;

setting a flag in the ADN record indicating a presence of an e-mail address in the Alpha Identifier field; [and]

allocating a third byte from said first number of bytes in the Alpha Identifier field in the ADN record for identifying a length of the e-mail address stored in the Alpha Identifier field[.];

wherein the ADN record further includes a Type of Number/Numbering Plan Identification (TON/NPI) field, and wherein the flag setting step comprises setting a flag in the TON/NPI field indicating a presence of an e-mail address in the Alpha Identifier field; and

wherein an NPI portion of the TON/NPI field includes four binary bits, and wherein the step of setting a flag in the TON/NPI field indicating the presence of an e-mail address in the Alpha Identifier field comprises setting the NPI portion of the TON/NPI field equal to binary "1110".

16. (Canceled)

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17. (Currently Amended) The method of claim [16] 15, wherein the flag set in the TON/NPI field indicating the presence of an e-mail address in the Alpha Identifier field is set in the NPI portion of the TON/NPI field.

18. (Canceled)

19. (Original) The method of claim 15, wherein the second number of bytes of memory space in the Alpha Identifier field is equal to or less than 241 bytes.

20. (Original) The method of claim 15, further comprising the step of coding the Dialing Number field as unused.

21. (Original) The method of claim 15, further comprising the step of storing an invalid phone number in the Dialing Number field.

22. (Previously Amended) The method of claim 15, further comprising the step of allocating a first byte in the Alpha Identifier field for identifying a second ADN record including a phone number for the particular subscriber contact.

23. (Previously Amended) The method of claim 22, wherein the second ADN network further includes a subscriber-defined alphanumeric tag associated with the particular subscriber contact.

24. (Currently Amended) The method of claim 15, further comprising the step of allocating a second byte in the Alpha Identifier field for identifying an extension record containing a remaining portion of the e-mail address if the second number of bytes of memory space allocated to the [Alpah] Alpha Identifier field in the ADN record is insufficient to store the e-mail address.

25. (Original) The method of claim 24, wherein the ADN record includes an Extension Record field for storing an extension record identifier, wherein the extension record identifier in the Extension Record field and the allocated second byte in the Alpha Identifier field each identify the extension record containing the remaining portion of the e-mail address if the second number of bytes of memory space allocated to the Alpha Identifier field in the ADN record is insufficient to store the e-mail address.

26. (Canceled)

27. (Previously Amended) The method of claim 15, further comprising the step of additionally storing a subscriber-defined alphanumeric tag associated with the particular subscriber contact in the Alpha Identifier field in the ADN record.

#### **REASONS FOR ALLOWANCE**

Claims 1-3, 5, 7-12, 14, 15, 17, 19-25, and 27 are allowed.



The following is an examiner's statement of reasons for allowance: The limitation including wherein an NPI portion of the TON/NPI field includes four binary bits, and wherein the step of setting a flag in the second field in the ADN record indicting the presence of an e-mail address in the first field in the ADN record comprises the step of setting the NPI portion of the TON/NPI field equal to binary "1110" (see enabling portions in the present specification, see Page 3, last paragraph, Page 4, lines 1-6, Page 15, lines 1-9) was not taught or suggested by the cited prior art of record in combination with the other limitations of all of the independent claims. The cited prior art of reference teaches a subscriber identifier being conceived as subscriber identifiers for electronic mail addresses but does not teach setting a flag in a field separate from the field containing the email address, where setting a flag includes setting the NPI portion of a TON/NPI field equal to binary "1110".

The dependent claims further limit the independent claims and are considered allowable on the same basis as the independent claims as well as for the further limitations set forth.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Drawings***

Examiner requests that Applicant submit formal drawings to the drafts person.

### ***Conclusion***

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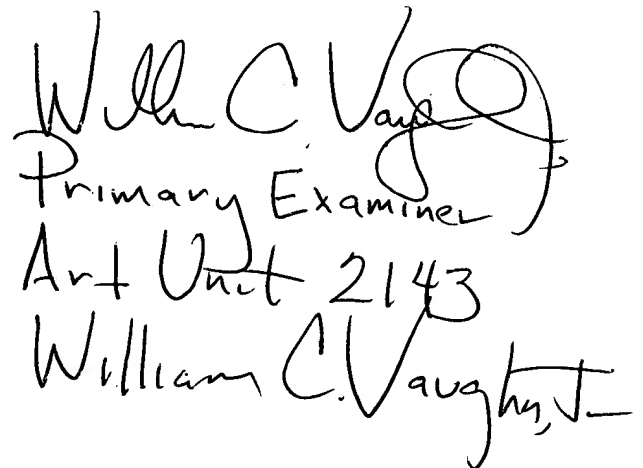
Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571)272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571)272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Bret Dennison  
Patent Examiner  
Art Unit 2143



William C. Vaughn, Jr.  
Primary Examiner  
Art Unit 2143  
William C. Vaughn, Jr.